

Examiner Interview

On August 12, 2002, Applicants' representative met with Examiner Raymond at his office. The outstanding office action was discussed in detail. The interview was accurately summarized in the Examiner Interview Summary Form prepared by the Examiner and entered in the record. The form summarizes the interview as follows:

Nonelected claims to be rejoined and arguments over prior art to be considered favorably.

It was also agreed that Applicants would submit this response to be considered by the Examiner.

The time and attention of the Examiner are greatly appreciated.

Restriction Requirement

In the outstanding Office Action, the previous Examiner maintained a Restriction Requirement that divided the application into two Groups:

Group I directed to the methods of claims 32-42, 44-48, 51, and 52; and

Group II, directed to the methods of claims 53-63.

This Restriction Requirement was discussed during the interview. The basis for maintaining the Restriction appeared to be that the claims "were not originally presented and are drawn to different methods of use." (Page 2, Office Action of March 5, 2004)

The traversal of this Restriction Requirement is maintained.

As stated in the Response of June 7, 2004, incorporated herein by reference, Applicants respectfully submit that the fact that claims 53-63 were not originally presented is not a valid reason, on its own, to withdraw the claims.

As discussed with Examiner Raymond, Applicants maintain that in the instant case, there is no showing that the inventions are independent and distinct. Additionally, there is no indication in the Office Action that the inventions are each classified differently and would require an undue amount of additional searching. Further, there is no indication that any additional searching or consideration (if in fact there is any) would be undue. The pyrimidine compounds, which are central to the claimed methods, and believed to control classification, overlap.

Furthermore, there is no indication that the position taken by the Final Office Action (page 2) that a preliminary search of the withdrawn process claims would yield a total of 31,208 (additional) hits if classified properly taking the compounds into consideration.

In view of the above, and in view of what was discussed at the interview, it is believed that the Examiner will withdraw the Restriction Requirement. As stated in the previous Response, originally a four-way Restriction Requirement was made. In order to expedite the prosecution of the Application, Applicants cancelled the non-elected claims in the Amendment that followed.

Issues Under 35 U.S.C. § 103

Claims 32-35, 37, 40, 42, 48, 51 and 52 stand rejected under 35 U.S.C. § 103 as allegedly being obvious over Henrie, II et al., US 5,521,192 in view of Treybig et al., US 4,871,848. This rejection is respectfully traversed. Reconsideration and withdrawal thereof are required.

This rejection has been discussed in detail in the record (for example, see pages 4-6 of the Response filed June 7, 2004) and was discussed during the interview.

The '192 patent is applied as a primary reference. As stated in the Office Action, '192 fails to disclose or suggest the claimed methods of the present invention.

The secondary reference, '848, was cited due to its alleged disclosure that several aromatic nitrogen-containing heterocycles, including pyrimidines (as a class, but the hydroxyl-containing pyrimidines of the present invention are not disclosed) can be used as corrosion inhibitors when applied to the inside metal walls of equipment such as oil well equipment, the inside metal walls of pipelines, and the inside metal walls of storage tanks, etc. The metal equipment corrosion inhibitor compositions of '848 forms a film on the metal surfaces of the equipment to protect the equipment. See col. 11, lines 7-10, where the "surface active agents" of '848 are discussed.

Thus, the '848 secondary reference fails to remedy the deficiencies of the primary reference in that it fails to disclose or suggest the methods of the present invention. That is, '848 fails to disclose or suggest the methods of reducing the oxidation rates in a petroleum composition.

Secondly, there is no suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill to select the references and combine them in the way suggested by the Office Action that would produce the claimed invention.

Basically, the crux of the argument set forth in the outstanding office action is that it would be obvious to take a select few of the insecticidal compounds disclosed in the huge generic Markush group of '192, and apply them in the process of '848, which isn't even the same as the instant process. Additionally, the '848 reference fails to disclose or suggest the hydroxyl-pyrimidines of the present invention.

It is clear, and as discussed during the interview, the previous office action presented the "obvious to try" situation in an attempt to negate patentability.

Since there was no motivation to piece together the references to arrive at the present invention, and since the references, when pieced together fail to disclose or suggest all of the claim limitations, Applicants respectfully request that this rejection be withdrawn.

Claims 32, 35, 36, 38, 39, and 41 stand rejected under 35 U.S.C. § 103 as allegedly being obvious over LaMattina, US 4,554,276 in view of Treybig et al., US 4,871,848. This rejection is respectfully traversed. Reconsideration and withdrawal thereof are required. The same issues discussed above are relevant to this rejection. '276 has deficiencies admitted in the Office Action. There is no motivation to combine '276 with the secondary reference ('848, discussed in detail above). Additionally, the two references, when combined, fail to disclose or suggest the subject matter as claimed. Accordingly, Applicants respectfully request that this rejection be withdrawn.

Claim Objections

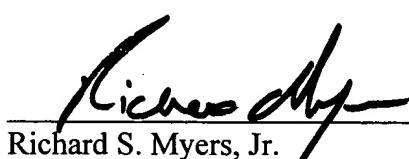
Applicants note that Claims 44-47 are objected to as being dependent upon a rejected base claim.

Finally, the previous office action indicated that “[a] complete reply to the final rejection must include cancellation of the nonelected claims or other appropriate action.” In view of the withdrawn Restriction Requirement as per the interview, it is not believed that the requested cancellation is necessary.

From the foregoing, further and favorable reconsideration is requested in the form of a Notice of Allowance and such action is believed to be in order.

If the Examiner has any questions concerning this Response or the Application in general, he is respectfully requested to contact the undersigned at the number listed below.

Respectfully submitted,



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